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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,795	06/29/2001	Akira Ishibashi	16869S-027900US	5584
20350 7590 11/02/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER GOTTSCALK, MARTIN A	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 11/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	09/895,795		ISHIBASHI ET AL.	
	Examiner		Art Unit	
	Martin A. Gottschalk		3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 17-21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/29/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. Claims 1-12, 15-21, and 23 are pending. Claims 13, 14, and 22 are cancelled. Claims 15 and 16 are withdrawn. Claims 1, 2, 7, 9, 12, 17, 18, and 21 are independent. Claims 1, 2, 9, 12, 17, and 21 are currently amended. The remaining claims are as per the original.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 recites the limitation "the transaction". There is insufficient antecedent basis for this limitation in the claim.

4. Claim 17 recites the limitation "the information" in lines 4 and 6 of the specification. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-14 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlisle et al (US Pat# 5,649,118) in view of Schimmel (PG Pub# US 2002/0103753).

A. As per claim 1, Carlisle teaches a settlement system configured to process transactions, the settlement system comprising:

an IC card (Carlisle: col 2, lns 21-30);

a transaction terminal (Carlisle: col 1, ln 67 to col 2, ln 3);

a plurality of settlement processors (Carlisle: col 2, lns 27-30);

an IC card-holder information storage unit configured to store therein: (i) IC card identification information based on which each of a plurality of IC cards including said IC card can be uniquely identified, and for each uniquely identified IC card (ii) settlement processor information for each settlement processor that is associated with said each

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uniquely identified IC card, wherein each of said plurality of IC cards including said IC card being associated with two or more of said settlement processors (Carlisle: col 2, lns 21-30);

an approval request receiving unit configured to receive, through said transaction terminal, IC card identification information, settlement processor designation information for specifying one or more of the plurality of settlement processors, and transaction information containing transaction amount data (Carlisle: Fig 13, items 112 and 114; col 21, lns 2-20);

and

a settlement request unit configured to generate settlement request information based on the transaction information and the settlement processor designation information and to transmit the settlement request information thus generated to one or more settlement processors specified by the settlement processor designation information (Carlisle: Fig 13, items 112 and 116; col 21, lns 2-20).

The system of Carlisle explicitly teaches the use of an IC card for the aforementioned features, but fails to explicitly teach a central apparatus distinct from the terminal and settlement processors which is functionally inserted between the terminal and the settlement processors, wherein the central apparatus contains the

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aforementioned units for card-holder information storage, approval request receiving, and settlement request. However, this feature is well-known in the art as evidenced by the teachings of Schimmel.

Schimmel teaches a settlement system utilizing multiple payment sources. Said system can be practiced in a distributed or centralized format (Schimmel: abstract; [0111], wherein the server running the "Charge Splitter Application" is the central apparatus). The central apparatus has the capabilities of card-holder information storage (Schimmel: [0120]-[0127]); approval request receiving and transition: (Schimmel: [0101]; [0111]; [0128]) and settlement requesting (Schimmel: [0116]-[0117]; [0128]; [0136]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the IC card payment system of Carlisle with the system of Schimmel for the reason of upgrading through retro-fit (rather than complete replacement, Schimmel: [0070]) the system of Carlisle by adding the ability to split the costs of a transaction between multiple payment sources (Schimmel: [0029]-[0030]) which might include other individuals who make contributory payments beyond the portion paid by the person purchasing the items (Schimmel: [0122]-[0130]).

B. Claims 2-12 and 17-21, and 23 are rejected substantially for the same reasons as provided for claim 1.

Response to Arguments

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4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.




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10/24/2007


JELLA COLBERT
PRIMARY EXAMINER